

## Office Action Summary

Application No.

09/961,234

Applicant(s)

ROYALL ET AL.

Examiner

Jean M Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on August 13, 2004, in which claims 1-8 are presented for further examination.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Remark***

3. Applicant asserted that the office action has failed to address the Applicants traverse of the restriction requirement. The examiner disagrees with the precedent assertion. It is noted, however, in the Applicant's response filed on April 23, 2004, group I, the Applicant has provisionally elected claims 1-8 with traverse. In addition, in the last office action mailed on August 13, 2004 (paper no. 7), the examiner had indicated that the grouping restriction requirement appears to be awkwardly written due to an inadvertent typographical error. Accordingly, appropriate correction was made, wherein group I includes claims 1-8 and Group II has claims 9-11. Furthermore, In the restriction requirement the examiner had provided a writing explanation as to why claims 1-11 are restricted, wherein the search requires for group I, claims 1-8 can not use for group II, claims 9-11, in which they are directed to two different groups of invention. The examination has clearly shown that group I, claims 1-8, is classify to 707/1, database access (accessing candidate database, see claims 1 and 7) and group II, claims 9-11, is classify to 705/10, demand forecasting (application for admission, see claim 9-11). Therefore, the restriction is proper and it sustains.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grady et al., "Sending GMAT score reports to schools: patterns of requests at registration" (hereinafter "Grady") and Tjaden et al., "A worldwide, web based study of the attitudes of college freshman toward computing" (hereinafter "Tjaden").

As to claim 1, Grady discloses a method for generating application from candidates interested in attending an educational institution (page 1). In particular, Grady discloses the claimed "accessing a candidate database containing personal information" by accessing the pool database for potential candidates (see Grady's pages 1-2); "profiling the candidates according to criteria established by the educational institution" (see Grady's pages 1-7); "segmenting the profiled

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candidates into a target group” categorizing those registrants who are well qualified and who meet the institution’s particular enrollment goals (see Grady’s pages 1-7); “providing a web site containing links to a survey and to the partial application” (see Grady’s pages 4-5). Grady fails to specifically provide each target candidate with an access number to ensure that each candidate to access his/her own personal information and wherein only one survey response or application is submitted by an individual candidate and also access to a partial application to the educational institution for enrollment.

Grady, however, discloses the use of constructing an electronic survey (automation of known GMAT registration process), creating a unique access number for each candidate by providing each candidate with his/her unique access number in an email request for information by an electronic survey and updating the database based on the response from the survey (automation of known GMAT registration process using Internet). It is important to note that Grady discloses a system that sends registrant (candidate) specified school information including GMAT scores, his/her undergraduate academic record and the registrant’s (candidate’s) background characteristics (age, sex, and race), wherein this information is useful to a recipient school in accessing the attributes of its applicants (evaluating candidates), in which enables the school to target those registrant who are well qualified and who meet the institution’s particular enrollment goals(Grady’s pages 1-7), based on the result holds despite the fact that respondents to the survey were in most cases asked to identify their first choice school well after they had taken the requirement test, so most of the respondents had gained knowledge of their requests for admission either accepted or denied. These implications have the functional limitations of allowing the candidate to have accessed to a partial application for enrollment thereby compiling

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the applications to the which have been electronically completed and then transmitting them to the educational institution

Tjaden, on the other hand, is directed to a system that initiates a worldwide survey of colleges and universities to re-evaluate attitudes of students toward computing courses and enables each institution to immediately view or inspect their own profile and compare their numbers to those of all other schools in the database (see Tjaden's page 29). Tjaden discloses the use of many diverse interest groups in the educational domain that gives rise to many interest requirements, wherein the students may wish to know how best to select courses based on prediction of how well they will perform in the course selected, wherein the alumni office may need to know how best to perform target mailing so as to achieve the best effort in reaching out to those alumni that are likely to respond. Tjaden recognizes that all those applications not only contribute towards the education institute delivering a better quality education experience, but also aid the institution in running its administrative tasks. Tjaden also understands the problem of allocating students to different groups and the question, how many groups should be allocated and how to decide the boundary of each group. Further, Tjaden discloses the use of a specific system that can be use to select the right students for various purposes. Such system of Tjaden includes web-based forms for effortless data entry, wherein the forms may be downloaded by the target candidates for manual data entry by those who so choose. More specifically, each target candidate is provided with an identification code in order to correlate data by institution, thereby providing the capability of allowing each target candidate to inspect his/her own profile and compare their numbers to those of all other school in the database (Tjaden's pages 31-32), similarly to the description provided by the specification pages 11-13. These implications also

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have the functional limitations of assigning a unique access number ("PIN") to each candidate in the target group; electronically mailing each candidate in the target group the assigned PIN and an invitation to use the PIN to access the web site; providing each candidate accessing the web site and indicating a continuing interest in the educational institution with electronic access to partial application; for each candidate who electronically accesses a partial application, customizing the partial application with personal information from the database; compiling the partial applications which have been electronically completed; and transmitting the partial application to the educational institution. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the use of providing candidates from the pool with an application for enrollment thereby compiling the applications to the which have been electronically completed and then transmitting them to the educational institution, in the combined system disclosed by Grady and Tjaden. One having ordinary skill in the art would have found it motivated to use to such a modification in Grady and Tjaden for the purpose of providing a method fro profiling an inquiry pool of candidates interest in attending an identified institution of higher learning preliminarily to targeting candidates from the pool with for enrollment, with the ability to increase system effectiveness by automating the process of storing, evaluating, reporting and targeting (forwarding applications, brochures, etc.,) potential candidates.

As to claims 2 and 4, it is noted, however, that Grady recognizes the true value to schools of score report, depends on the extent to which it predicts a registrant's subsequent behavior, in which if the registrant is unlikely to apply to the school where the score report was sent or would

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not enroll if admitted, the report has little value as a planning or marketing tool, therefore, Grady found it important to provide evidence about whether these choices predict the specific school to which registrants will apply and at which they will matriculate that would help to determine both the extent to which registrants have a well defined set of schools they are interested in attending, and whether this set of schools is indicated by their score sending choices, wherein those in which registrants will apply and at which they will matriculate and will acknowledge for their interest (Grady's page 1). These implications provide the use of providing a personalized acknowledgement of each application received and inviting each candidate (registrant) to submit a full application. Grady does not explicitly disclose the use of providing electronic access through use of the PIN to a full application customized with personal information from the updated database. On the other hand, Tjaden discloses the use of providing electronic access through use of the PIN to a full application customized with personal information as a purpose of allowing a participating candidate to inspect his/her own profile (page 31-32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of the cited references by incorporate in Grady the use of providing electronic access through use of the PIN to a full application customized with personal information in order to provide the capability of allowing a participating candidate to inspect his/her personal data.

As to claim 3, Grady discloses a method for generating application from candidates interested in attending an educational institution (page 1). In particular, Grady discloses the claimed "accessing a candidate database containing personal information" by accessing the pool database

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for potential candidates (see Grady's pages 1-2). Grady fails to specifically provide each target candidate with a partial application to the educational institution for enrollment. Grady, however, discloses a system that sends registrant (candidate) specified school information including GMAT scores, his/her undergraduate academic record and the registrant's (candidate's) background characteristics (age, sex, and race), wherein this information is useful to a recipient school in accessing the attributes of its applicants (evaluating candidates), in which enables the school to target those registrant who are well qualified and who meet the institution's particular enrollment goals (Grady's pages 1-7), based on the result holds despite the fact that respondents to the survey were in most cases asked to identify their first choice school well after they had taken the requirement test, so most of the respondents had gained knowledge of their requests for admission either accepted or denied. These implications have the functional limitations of allowing the candidate to have accessed to a partial application for enrollment thereby compiling the applications to which have been electronically completed to the educational institution

Tjaden, on the other hand, is directed to a system that initiates a worldwide survey of colleges and universities to re-evaluate attitudes of students toward computing courses and enables each institution to immediately view or inspect their own profile and compare their numbers to those of all other schools in the database (see Tjaden's page 29). Tjaden discloses the use of many diverse interest groups in the educational domain that gives rise to many interest requirements, wherein the students may wish to know how best to select courses based on prediction of how well they will perform in the course selected, wherein the alumni office may need to know how best to perform target mailing so as to achieve the best effort in reaching out to those alumni that are likely to respond. Tjaden recognizes that all those applications not only



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contribute towards the education institute delivering a better quality education experience, but also aid the institution in running its administrative tasks. Tjaden also understands the problem of allocating students to different groups and the question, how many groups should be allocated and how to decide the boundary of each group. Further, Tjaden discloses the use of a specific system that can be use to select the right students for various purposes. Such system of Tjaden includes web-based forms for effortless data entry, wherein the forms may be downloaded by the target candidates for manual data entry by those who so choose. More specifically, each target candidate is provided with an identification code in order to correlate data by institution, thereby providing the capability of allowing each target candidate to inspect his/her own profile and compare their numbers to those of all other school in the database (Tjaden's pages 31-32), similarly to the description provided by the specification pages 11-13. These implications disclose the use of providing each candidate with a partial application for each candidate who electronically accesses a partial application. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the use of providing candidates from the pool with an application for enrollment thereby compiling the applications to the which have been electronically completed and then transmitting them to the educational institution, in the combined system disclosed by Grady and Tjaden. One having ordinary skill in the art would have found it motivated to use to such a modification in Grady and Tjaden for the purpose of providing a method fro profiling an inquiry pool of candidates interest in attending an identified institution of higher learning preliminarily to targeting candidates from the pool with for enrollment, with the ability to increase system effectiveness by automating the process of

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storing, evaluating, reporting and targeting (forwarding applications, brochures, etc.,) potential candidates.

As to claims 7-8, the limitations of claims 7-8 have been noted in the rejection of claims 1-3 above. They are, therefore, rejected under the same rationale.

7. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grady et al., and Tjaden et al., as applied to claims 1-3 above, and further in view of Sharma et al., (hereinafter "Sharma") article entitled "Retraining for a graduate program in computer science".

As to claims 4-6, Grady and Tjaden disclose substantially the invention as claimed. However, neither Grady nor Tjaden discloses the use of providing candidates who are invited to submit a complete application an incentive in return.

Sharma, on the other hand, in view of the shortage of computer specialists, recognizes that it would be difficult to attract students with BS degrees in computer science. Sharma, however, as a partial solution, prepares students with BS degrees in other areas for entrance to a graduate program by starting to offer accelerates programs (pages 284-285). This implication discloses the claimed offering each candidate invited to submit an application an incentive to submit the application and using the criteria established by the educational institution for the target group. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include into Grady and Tjaden's combined system the use of providing candidate who are invited to submit a complete application an incentive in return. One having ordinary skill in the art would have found it motivated to use to such a modification in Grady and

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Tjaden's combined system for the purpose of encouraging potential candidates in enrolling in the educational institution of interest.

*Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032.

The examiner can normally be reached on Monday - Friday (7:00am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M. Corrielus

Patent Examiner

December 23, 2004